

## **REMARKS**

Amendments to claims 1, 22, and 29 are for the purpose of clarifying what Applicant regards as the invention. No new matter has been added.

### **I. CLAIMS OBJECTIONS**

Claims 70 and 72 stand objected to. Claims 70 and 72 have been canceled, thereby rendering the claim objections moot.

### **II. CLAIMS REJECTIONS UNDER 35 U.S.C. § 102**

Claims 29, 32-33, 36-37, 40, 43, 45-47, 66-67, and 72 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Ogawa (U.S. Patent No. 6,278,760). Applicant respectfully notes that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 29 has been amended to recite creating *a contrast-enhanced volumetric composite image* using the first and the second sets of image data, wherein *the contrast-enhanced volumetric composite image is created such that at least a portion of the contrast-enhanced volumetric composite image has a feature indicating cancerous tissue* (Emphasis Added). Ogawa does not disclose or suggest creating a contrast-enhanced volumetric composite image, nor does Ogawa disclose or suggest that at least a portion of a contrast-enhanced volumetric composite image has a feature indicating cancerous tissue.

Claim 29 also recites at least one of storing the contrast-enhanced volumetric composite image and displaying the contrast-enhanced volumetric composite image. Ogawa also does not disclose or suggest such limitations.

For at least the foregoing reasons, Applicant respectfully submits that claim 29 and its dependent claims are allowable over Ogawa.

### **III. CLAIMS REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1-2, 4-7, 10-14, 17-28, 30-31, 38-39, 44, 56-59, and 61-65 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ogawa in view of Hughes et al. (U.S. Patent No. 4,432,370).

Claim 1 has been amended to recite creating *a contrast-enhanced volumetric composite image* using the first and the second sets of image data, wherein the contrast-enhanced volumetric composite image is created such that at least a portion of the contrast-enhanced volumetric composite image *has a feature indicating cancerous tissue* (Emphasis Added). Claim 22 has been amended to recite similar limitations. Applicant respectfully submits that the amendments to claims 1 and 22 have rendered the § 103 rejection moot with respect to Ogawa and Hughes. In particular, Applicant respectfully notes that both Ogawa and Hughes do not disclose or suggest creating a contrast-enhanced volumetric composite image, nor do they disclose or suggest that a portion of a contrast-enhanced volumetric composite has a feature indicating cancerous tissue. Since both Ogawa and Hughes fail to disclose or suggest the above limitations, any combination of these references, and their combined teaching, cannot result in the subject matter of claims 1 and 22. For at least the foregoing reasons, amended claims 1 and 22, and their respective dependent claims, are believed allowable over Ogawa, Hughes, and their combination.

Also, in the Advisory Action, in supporting the previous § 103 rejection, it is stated that both Ogawa and Hughes “are capable of being combined” and that these references “share many similarities already, such as multi-energy imaging and subtraction techniques.” However, Applicant respectfully notes that just because features from two references are allegedly *capable* of being combined, that alone cannot sustain a prima facie case of a § 103 rejection. Also, just because two references allegedly disclose similar elements, that also cannot be the basis for a prima facie case of a § 103 rejection. Rather, there must be a legitimate motivation for one skilled in that art to combine the references in the purported manner. Here, Hughes specifically teaches using contrast to create high fidelity picture of *the entire circulatory tree* for diagnosing cardiovascular condition. However, there is nothing in the record indicating that the system of Ogawa has any need to create a high fidelity picture of the entire circulatory tree. Rather, Ogawa is concerned with eliminating bone images to highlight soft tissue (column 7, lines 41-43), which according to the teaching of Ogawa, is achieved without any use of contrast agent. Thus, one skilled in the art who is concerned with eliminating bone images would have no reason to use contrast for creating a high fidelity picture of the entire circulatory tree (which is completely unrelated to the objective of eliminating bone images). For these additional reasons, Applicant respectfully submits that claims 1 and 22, and their respective dependent claims, are allowable

over Ogawa, Hughes, and their combination, and that these references cannot support a prima facie case of a § 103 rejection (especially in view of claims 1 and 22 as amended).

Claims 1, 6-10, 14, 17, 19-21, 29, 32-37, 39-40, 43, 45-47, 56-57, 60-68, 70, and 72 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ogawa in view Acharya (U.S. Patent No. 6,922,462).

Claim 1 has been amended to recite creating *a contrast-enhanced volumetric composite image* using the first and the second sets of image data, wherein the contrast-enhanced volumetric composite image is created such that at least a portion of the contrast-enhanced volumetric composite image *has a feature indicating cancerous tissue* (Emphasis Added). Claim 29 has been amended to recite similar limitations. Applicant respectfully submits that the amendments to claims 1 and 29 have rendered the § 103 rejection moot with respect to Ogawa and Acharya. In particular, Applicant respectfully notes that both Ogawa and Acharya do not disclose or suggest creating a contrast-enhanced volumetric composite image, nor do they disclose or suggest that a portion of a contrast-enhanced volumetric composite has a feature indicating cancerous tissue. Since both Ogawa and Acharya fail to disclose or suggest the above limitations, any combination of these references, and their combined teaching, cannot result in the subject matter of claims 1 and 29. For at least the foregoing reasons, amended claims 1 and 29, and their respective dependent claims, are believed allowable over Ogawa, Acharya, and their combination.

Also, in the Advisory Action, in supporting the previous § 103 rejection, it is stated that both Ogawa and Acharya “are capable of being combined” and that these references disclose similarities elements. However, as discussed, Applicant respectfully notes that just because features from two references are allegedly capable of being combined, that alone cannot sustain a prima facie case of a § 103 rejection. Also, just because two references allegedly disclose similar elements, that also cannot be the basis for a prima facie case of a § 103 rejection. Rather, there must be a legitimate motivation for one skilled in that art to combine the references in the purported manner. Here, Acharya specifically teaches using contrast to *characterize plaque*. However, there is nothing in the record indicating that the system of Ogawa has any need to characterize plaque. Rather, Ogawa is concerned with eliminating bone images to highlight soft tissue (column 7, lines 41-43), which according to the teaching of Ogawa, is achieved without

any use of contrast agent. Thus, one skilled in the art who is concerned with eliminating bone images would have no reason to use contrast to characterize plaque (which is completely unrelated to the objective of eliminating bone images). For these additional reasons, Applicant respectfully submits that claims 1 and 29, and their respective dependent claims, are allowable over Ogawa, Acharya, and their combination, and that these references cannot support a prima facie case of a § 103 rejection (especially in view of claims 1 and 29 as amended).

**CONCLUSION**

If the Examiner has any questions or comments regarding this amendment, please contact the undersigned at the number listed below.

To the extent that any arguments and disclaimers were presented to distinguish prior art, or for other reasons substantially related to patentability, during the prosecution of any and all parent and related application(s)/patent(s), Applicant(s) hereby explicitly retracts and rescinds any and all such arguments and disclaimers, and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Vista IP Law Group's Deposit Account No. 50-1105, referencing billing number **VM 03-029 US**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Vista IP Law Group's Deposit Account No. 50-1105, referencing billing number **VM 03-029 US**.

Respectfully submitted,

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